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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86041474
Applicant	Creations By Sherry Lynn, LLC
Applied for Mark	NECKLETTE
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

)	IN RE:	APPLICATION OF CREATIONS BY SHERRY LYNN, LLC
)	MATTER:	EX PARTE APPEAL
)	SER. NO.:	86041474
)	MARK:	NECKLETTE
)		(WORD MARK)
)	EXAMINING ATTORNEY:	D.BERYL GARDNER
)	LAW OFFICE:	117

BRIEF FOR APPELLANT

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I. Introduction

Applicant hereby appeals from the Examiner's refusal to register the above-identified mark and respectfully requests the Trademark Trial and Appeal Board reference the Examiner's decision. An oral hearing may be requested by separate notice. On May 5, 2015, the undersigned, a newly appointed attorney for the applicant supplemented the record with additional support for the Appellant's position. References are made to 37 CFR § 2.142(d), TBMP § 1207.02 and see *In re Johana Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984) and *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984). Because of the intended use of the Applicant's goods, the mark is not descriptive.

II. Application's Trademark

Applicant seeks registration on the Principal Register of its mark:

NECKLETTE

For jewelry, namely, bracelets, wristbands and necklaces that also provide notification of a pending medical related task; jewelry, namely magnetic necklaces; necklaces.

III. Applicant's Arguments in Support of Withdrawal of Refusal and Approval for Publication:

A. The Applicant's mark is not descriptive; it is suggestive.

1. The Applicant's Mark is not descriptive.

Applicant's goods augment and physically change (as opposed to merely accessorize) articles of clothing. Moreover, they also communicate important information to "the wearer of a pending medical related task." As such, they are not "necklaces" as such term is commonly used. The use of the word "NECKLETTE" is in fact a play on words in that the Applicant's goods are never worn as bracelets or necklaces either. The suffix "lette" is a diminutive meaning slight or lesser than. <http://www.wordsense.eu/lette/> Used in the context of the Applicant's goods, it simply infers or suggests that it is something less than a necklace. Indeed, the articles do not fasten around the neck or wrist of the wearer – they attach directly to the clothing itself and they are held in place magnetically (not draped as a traditional necklace would be). When used in this context and when targeted to this specific market, the mark is not descriptive because it does not immediately (or with even a significant degree of imagination) convey the product's purpose, features or functions. Insofar as the mark connotes more than one meaning, it is, at most, suggestive; accordingly, it is not "merely" descriptive.

(a) Standard for descriptiveness.

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to

which it relates. TMEP § 1209.01(b). The determination of whether a mark is merely descriptive must be made in **relation to the goods or services for which registration is sought, not in the abstract**. *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831 (emphasis added). Such a determination requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. TMEP § 1209.01(b). Because the line between merely descriptive and protected, suggestive terms is a nebulous one, the Board generally takes the position that doubt is to be resolved in favor of the Applicant; the theory being that once published, competitors will have the opportunity to oppose and present evidence. See MCCARTHY § 11:51 citing *In re Conductive Systems, Inc.*, 220 USPQ 84 (TTAB 1983) wherein the Board held that doubts under § 2(e) (as opposed to § 2(d)) about the merely descriptive nature of a term are to be resolved in favor of the applicant); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972) (where the Board held that LONG ONE for bread was not descriptive); *In re Morton-Norwich Products, Inc.* 209 USPQ 791 (TTAB 1981) (where COLOR CARE for laundry bleach received similar disposition); *In re Aid Laboratories, Inc.*, 221 USPQ 2d 1215 (TTAB 1983) (PEST PRUF for animal shampoo containing insecticides was held to be on the merely suggestive side of the line).

To be characterized as “descriptive,” a term must **directly** give some reasonably accurate or tolerably distinct knowledge of the characteristics of a product. McCarthy §11:19 citing *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961) and *Robert Bruce, Inc. v. Sears et. al.*, 343 F.Supp. 1333, 174 USPQ 94 (E.D. Pa. 1972) (emphasis added). If information about the product or services given by the term used as a mark is indirect or vague, then this indicates that the term is being used in a “suggestive,” not descriptive, manner. MCCARTHY at §11. If a term has elements of **imagination**, the term will be classified as **suggestive, not descriptive**. *Id.* (emphasis added). A mark that connotes two meanings – even if one is possibly descriptive and the other is suggestive of some other association – can be classified as suggestive because the mark is not “merely “ descriptive. *Id.* For example, the mark POLY PITCHER on polyethylene pitchers both connotes a description of the plastic ingredient of the product and it is also reminiscent or suggestive of Molly Pitcher of Revolutionary lore. That mark was found to be an incongruous expression. *Id.* citing *Blisscraft*. Similarly, the mark SUGAR & SPICE for bakery products not only suggests ingredients , but stimulates and association with the nursery rhyme “Sugar and Spice and Everything Nice ...” In holding this use not a merely descriptive one, the court emphasized this “reminiscent, suggestive, or associative connotation” with a non-descriptive idea. MCCARTHY citing *In re Colonial Stores, Inc.* 34 F.2d 549, 157 USPQ 382 (CPA 1968) and *Sweetarts v. Sunline, Inc.*, 380 F.2d 923, 154 USPQ 459 (8th Cir. 1967) (holding that SWEETARTS candy was non-descriptive).

(b) Standard has not been met.

Because the Applicant's mark connotes no information whatsoever regarding an important underlying feature of the Applicant's goods (i.e., to notify the wearer of impending medical tasks), it is not descriptive. Similarly and insofar as the goods are not worn as "necklaces or bracelets," the mark does not describe any other feature of the goods either.

2. The mark is suggestive and hence, capable of registration on the Principal Register.

(a) Identification of suggestive marks.

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. TMEP § 1209.01(a). Thus, a suggestive term differs from a descriptive term – the latter being used to describe a term that immediately communicates something about the goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of anti-perspirant deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described). Similarly, the term NECKLETTE merely suggest or hints at the manner in which the Applicant's goods are applied and used.

(b) Incongruous marks tend to be suggestive.

Incongruity is a strong indication that a mark is suggestive rather than merely descriptive. *In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978) (TENNIS IN THE ROUND held not merely descriptive for providing tennis facilities). The Board has described incongruity in a mark as "one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark," and has noted that the concept of mere descriptiveness "should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause.'" *In re Shutts*, 217 USPQ 363, 364–5 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool); *see also In re Vienna Sausage Mfg. Co.*, 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners, the Board finding that although

“frank” may be synonymous with “wiener,” and “wurst” is synonymous with “sausage,” the combination of the terms is incongruous and results in a mark that is no more than suggestive of the nature of the goods); *In re Getz Found.*, 227 USPQ 571, 572 (TTAB 1985) (MOUSE HOUSE held fanciful for museum services featuring mice figurines made up to appear as human beings, the Board finding that the only conceivable meaning of “mouse house,” i.e., a building at a zoo in which live and/or stuffed mice are displayed, is incongruous). In the case at bar, the combination of the first syllable in the word “necklace” and the second syllable in the word “bracelet” creates an incongruity that is indicative of the Applicant’s suggestive use of the mark in connection with goods that do not function primarily as either necklaces nor bracelets. “Necklette” is not a term that is used in the common vernacular to connote the Applicant’s goods; indeed the Applicant’s goods are novel in terms of their intended uses. As used in connection with the Applicant’s goods, the French-origin suffix “lette” is phonetically suggestive of the use Applicant’s goods for notification or alert purposes.

(c) **Suggestive marks are allowed on the Principal Register.**

Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. TMEP and see *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). Therefore, a designation **does not** have to be devoid of **all** meaning in relation to the goods/services to be registrable. *Id.* (emphasis added). If, after conducting independent research, it is unclear to the examining attorney whether a term in a mark has meaning in the relevant industry, the examining attorney must make an inquiry of the applicant, pursuant to 37 C.F.R. §2.61(b). In the case at bar, the Applicant has attempted to communicate the relevant industry to the Examiner.

3. The mark is also a *Double Entendre* and as such, is protectable and capable of registration on the Principal Register.

A “double entendre” is a word or expression capable of more than one interpretation. For trademark purposes, a “double entendre” is an expression that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the “double entendre” **will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.** TMEP § 12.13.05(c) (*emphasis added*).

The following cases illustrate situations where marks were considered to be “double entendres” and, therefore, registrable unitary marks: *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE for bakery products); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008)

(holding THE FARMACY registrable for retail store services featuring natural herbs and organic products and related health and information services relating to dietary supplements and nutrition); *In re Simmons Co.*, 189 USPQ 352 (TTAB 1976) (THE HARD LINE for mattresses and bed springs); *In re Del. Punch Co.*, 186 USPQ 63 (TTAB 1975) (THE SOFT PUNCH for noncarbonated soft drink); *In re National Tea Co.*, 144 USPQ 286 (TTAB 1965) (NO BONES ABOUT IT for fresh pre-cooked ham). Similarly, the Applicant's mark should not be refused registration because at least one of the Applicant's meanings is not merely descriptive – with respect to either the application of the Applicant's goods or their use in the provision and communication of reminder notifications.

B. The Examiner's Internet examples are literal and descriptive; the Applicant's usage is not.

The online examples identified by the Examining Attorney actually support the Applicant's position; i.e., whereas the Applicant is using the moniker in a suggestive, fanciful way for an item that attaches to clothing and communicates information to the wearer, in contrast, the users cited by the Examining Attorney are using the term in a literal sense that requires no imagination whatsoever (e.g. CAMINETTE for camisoles, LEMONETTE for lemon-flavored salad dressing).

C. Examples of registered/approved marks incorporating the suffix "lette" that require no imagination.

Reference is also made to the registrations and/or approved applications, attached hereto collectively as Exhibit 1 and incorporated herein by this reference, wherein the diminutive suffix "ette" is used in connection with the exact articles referenced in each such mark. It is the Applicant's position that far more imagination is required to glean the nature of Applicant's goods from the mark NECKLETTE.

IV. Conclusion

For the reasons hereinabove stated, the undersigned respectfully appeals to the Board to withdraw the Examiner's refusal and permit the Applicant's application to proceed to publication.

Respectfully submitted,

/ccw/

Christine C. Washington, Esq.
Attorney for Applicant

EXHIBIT "1"

United States of America
United States Patent and Trademark Office

CAMIETTE

Reg. No. 3,710,385 FREDRICK'S OF HOLLYWOOD CROUT INC. (NEW YORK CORPORATION)
Registered Nov. 10, 2009 1115 BROADWAY, 11TH FLOOR
NEW YORK, N.Y. 10013

Int. Cl.: 25 FOR: LADIES' BRAS, BRALETTES, CAM SOLETS IN CLASS 25 (U.S. CLS. 22 AND 32).

TRADEMARK FIRST USE 6-2-2009; IN COMMERCE 6-2-2009.
PRINCIPAL REGISTER THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 77 647,609, FILED 1-12-2009

ALEX KEAM, EXAMINING ATTORNEY



David J. Kappas

United States Patent and Trademark Office

United States of America
United States Patent and Trademark Office

LEMONETTE

Reg. No. 4,764,550

Registered June 30, 2015

Int. Cl.: 30

TRADEMARK

PRINCIPAL REGISTER

LEMONETTE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY), DBA LEMONETTE
SALAD DRESSINGS
16840 SEVERO PLACE
ENCINO, CA 91436

FOR: SALAD DRESSING, IN CLASS 30 (U.S. CL. 46).

FIRST USE 5-13-2010; IN COMMERCE 7-26-2014.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 86-452,785, FILED 11-12-2014.

LEIGH CAROLINE CASE, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office